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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JEAN-LOUIS H. GUERET

Appeal 2008-5036¹
Application 10/084,975
Technology Center 3732

Decided:² February 23, 2009

Before TONI R. SCHEINER, DEMETRA J. MILLS, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

¹ Oral Hearing February 12, 2009.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b).

The following claims are representative.

1. A device for applying a product to keratinous fibers, the device comprising:

a stem having two opposite ends; and

a brush portion connected to one end portion of the stem, the one end portion of the stem having a longitudinal axis and the brush portion having a free end that is not aligned with the longitudinal axis of the one end portion of the stem,

wherein the brush portion comprises a core having a core free end, at least part of the core being curved such that a line tangent to the core at any axial position along the core is not perpendicular to the longitudinal axis of the one end portion of the stem and a longitudinal axis of the core free end is not parallel to the longitudinal axis of the one end portion, and

wherein the brush portion further comprises bristles connected to the core, the bristles comprising ends defining an envelope surface having a varying cross-section along at least a part of its length, the envelope surface being asymmetrical about a midplane of the envelope surface, the midplane being oriented perpendicular to the core.

14. The device of claim 3, wherein the nonrectilinear edge portion. is defined by an intersection of a frustoconical-shaped zone of the blank and a frustoconical-shaped body portion of the blank, the frustoconical-shaped zone being proximate a free end of the blank and converging toward the free end of the blank, and the frustoconical-shaped body portion extending from the intersection and converging toward an end of the blank opposite the free end of the blank.

43. A method of making an applicator for applying a product to keratinous fibers, the method comprising:

providing a blank comprising a blank core and bristles connected to the blank core, the bristles comprising ends defining a blank envelope surface having a varying cross-section over at least a part of its length and being asymmetrical about a midplane of the blank envelope surface, the midplane being perpendicular to the blank core; and

curving at least a part of the blank core so as to form a brush portion comprising a core having a core free end and a brush portion free end not aligned with a longitudinal axis of an end portion of a stem to which the brush portion is adapted to be connected,

wherein a line tangent to the core at any axial position along the core is not perpendicular to the longitudinal axis of the end portion of the stem and a longitudinal axis of the core free end is not parallel to the longitudinal axis of the end portion when the brush portion is connected to the end portion of the stem.

Cited References

Ashtary et al. (Ashtary)	5,176,156	Jan. 5, 1993
Gueret	5,937,870	Aug. 17, 1999

Grounds of Rejection

1. Claims 1-12, 20-27, 33-51, 61, 62, 64-72, 75-88, 91-104, 107, and 108-111 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gueret in view of Ashtary.
2. Claims 14-16 and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gueret in view of Ashtary.

ISSUE

The Examiner contends with regard to the claimed device for applying a product to keratinous fibers, that Gueret discloses one end of the stem having a longitudinal axis and a brush portion having a free end (104) and discloses the brush portion is formed from a blank comprising a blank core and blank bristles defining a blank surface, an edge of the blank surface being nonrectilinear and the rectilinear edge portion being outwardly concave (Fig. 1e) (Ans. 3-4).

Appellant argues that:

Neither Gueret nor Ashtary, nor any combination thereof, provides any disclosure or suggestion of a device including, among other features, a “brush portion having a free end that is not aligned with [a] longitudinal axis of [an] end portion of [a] stem” connected to the brush portion, as recited in independent claims 1, 64, 80, and 96.

(Br. 14). Appellant further argues that Gueret and Ashtary lack any disclosure or suggestion of a method of making an applicator, including, among other features, “curving at least a part of [a] blank core so as to form a brush portion comprising . . . a brush portion free end not aligned with a longitudinal axis of an end portion of a stem to which the brush portion is adapted to be connected,” as recited in independent claim 43. (Br. 14.)

The issue is whether the cited references, in combination, disclose a “a brush portion connected to one end portion of the stem, the one end portion of the stem having a longitudinal axis and the brush portion having a free end that is not aligned with the longitudinal axis of the one end portion of the stem,” as in claim 1 and whether the cited references disclose “curving at least a part of the blank core so as to form a brush portion

comprising a core having a core free end and a brush portion free end not aligned with a longitudinal axis of an end portion of a stem to which the brush portion is adapted to be connected,” as recited in independent claim 43.

FINDINGS OF FACT

The Examiner finds that:

1. Gueret discloses a mascara brush (Figs. 1-3) comprising a container (320) comprising a mascara product to apply to eyelashes, a wiper (321), a handle (323) attached to an end of a stem (101), a brush portion connected to one end portion of the stem (101.1), the one end of the stem having a longitudinal axis and a brush portion having a free end (104); the brush portion comprising a twisted wire core (103) having a left hand pitch (Fig. 1d), at least part of the core being curved; the brush portion further having bristles of different lengths (Fig. 1) comprising ends defining an envelope surface being asymmetrical about a midplane of the envelope surface; the brush portion is formed from a blank comprising a blank core and blank bristles defining a blank surface, an edge of the blank surface being nonrectilinear and the rectilinear edge portion being outwardly concave (Fig. 1e). (Ans. 3-4.)
2. With regard to claims 4-8, 10-12, 20-21, 51, 67-68, 83-84, 99-100, Gueret also discloses the blank envelope surface being substantially axially, circularly symmetrical about the longitudinal axis of the core, the envelope surface and the brush portion having a maximum and a minimum cross section located between axial ends of the envelope surface and the brush portion, the nonrectilinear edge portion being located in one of the first third

and a last third of the length of the blank envelope surface (Figs. 1a, b). (Ans. 4.)

3. With regard to claims 64-66, 69-72, 75-82, 85-88, and 91-95, Gueret also discloses the envelope surface (129b) being noncylindrical proximate a free end (at 128b) of a brush portion (120). (Ans. 4.)

4. Gueret does not disclose the free end of the brush portion not being aligned with the longitudinal axis of the one end portion of the stem and the brush portion comprising a core having a core free end, at least part of the core being curved such that a line to the core at any axial position along the core is not perpendicular to the longitudinal axis of the one end portion of the stem and a longitudinal axis of the core free end is not parallel to the longitudinal axis of the end portion. (Ans. 4.)

5. Ashtary discloses a mascara brush (Fig. 2) comprising a stem (16) with two opposite ends, a brush portion (32) connected to one end (at 34) portion of the stem and the one end portion of the stem having a longitudinal axis and the brush portion having a free end that is not aligned with the longitudinal axis of the one end portion of the stem and the brush portion comprising a core (30) having a core free end (free end of brush 32), at least part of the core being curved (col. 3, ll. 61-64) such that a line to the core at any axial position along the core is not perpendicular to the longitudinal axis of the one end portion of the stem and a longitudinal axis of the core free end is not parallel to the longitudinal axis of the end portion (Fig. 2). (Ans. 4.)

6. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the particular brush portion as taught by Ashtary into the mascara brush of Gueret for the purpose of enhancing the ability of the device to curl the eyelashes. (Ans. 5.)

7. In regard to claims 43-50 and 61-62, the above apparatus is inherently seen in the existence method claims. (Ans. 5.)

8. Claims 14-16 and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gueret in view of Ashtary. (Ans. 5.)

Other relevant facts of record:

9. Gueret discloses a mascara brush having a fish-like shape (Gueret, Fig. 1), and a frustoconical shape (Fig. 2A).

10. Gueret further evidences that those of ordinary skill in the art understand that mascara brushes may optionally be curved. (Gueret, Figs. 1d, 1E, 2D; and col. 5, ll. 29-40.)

PRINCIPLES OF LAW

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness.” *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. In order to determine whether a *prima facie* case of obviousness has been established, we considered the factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1996): (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, (3) the level

of ordinary skill in the relevant art, and (4) objective evidence of nonobviousness, if present.

“[O]bviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

Drawings can disclose claimed structure if they clearly show the structure which is claimed. *In re Mraz*, 455 F.2d 1069, 1072 (CCPA 1972).

The Supreme Court has emphasized that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 550 U.S. 398, ___, 127 S. Ct. 1727, 1741 (2007). As to motivation to combine, the Supreme Court in *KSR* rejected a rigid application of the teaching-suggestion-motivation test. The Court recognized that it is often necessary to look at the interrelated teaches of multiple references; the effects of demands of the marketplace; and the background knowledge possessed by a person of ordinary skill, “all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed.” *Id.* at 1740-41. Moreover, the “obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, or motivation, or by overemphasis on the

importance of published articles and explicit content of issued patents.” *Id.* at 1741.

ANALYSIS

1. Claims 1-12, 20-27, 33-51, 61, 62, 64-72, 75-88, 91-104, 107, and 108-111 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gueret in view of Ashtary. Appellant provides separate argument for claims 1 and 43 with respect to this rejection and therefore these claims are representative of the rejection before us. 37 C.F.R. § 41.37(c)(1)(vii).

Claim 1

Appellant contends that neither Gueret nor Ashtary, nor any combination thereof, provides any disclosure or suggestion of a device including, among other features, a “brush portion connected to one end portion of the stem, the one end portion of the stem having a longitudinal axis and the brush portion having a free end that is not aligned with the longitudinal axis of the one end portion of the stem,” as recited in independent claims 1, 64, 80, and 96. (Br. 14-15.)

Appellant contends that the text of Ashtary does not describe the claimed subject matter. (Br. 15.)

We are not convinced by Appellant's argument. The Examiner relies on Figure 2 of Ashtary as showing the claimed features and not the text. An applicant can show possession of a claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d at 1572

(Fed. Cir. 1997). Thus, the figures of Ashtary are considered part of the disclosure and may be relied on to reject the pending application.

Ashtary discloses a mascara brush (Fig. 2) comprising a stem (16) with two opposite ends, a brush portion (32) connected to one end (at 34) portion of the stem, and the one end portion of the stem having a longitudinal axis and the brush portion having a free end that is not aligned with the longitudinal axis of the one end portion of the stem and the brush portion comprising a core (30) having a core free end (free end of brush 32), at least part of the core being curved (col. 3, lines 61-64) such that a line to the core at any axial position along the core is not perpendicular to the longitudinal axis of the one end portion of the stem, and a longitudinal axis of the core free end is not parallel to the longitudinal axis of the end portion (Fig. 2). (FF5.)

Appellant argues that Figure 2 of Ashtary is not a clear figure. (Br. 15.) However, we agree with the Examiner that Figure 2 of Ashtary clearly show a device having one end portion of the stem having a longitudinal axis and the brush portion having a free end that is not aligned with the longitudinal axis of the one end portion of the stem and the brush portion comprising a core (30) having a core free end (free end of brush 32), at least part of the core being curved, as claimed. We disagree with Appellant that Figure 2 of Ashtary is not a clear figure. We find that, Figure 2 of Ashtary, on its face, discloses a curved mascara brush including the limitation claimed.

Moreover, Ashtary's text does disclose at least part of the core being curved (col. 3, ll. 61-64). (FF5.)

Appellant further contends there is no motivation to combine the cited references. (Br. 16-18.)

The Supreme Court has emphasized that "the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, ___, 127 S. Ct. 1727, 1741 (2007). As to motivation to combine, the Supreme Court in *KSR* rejected a rigid application of the teaching-suggestion-motivation test. The Court recognized that it is often necessary to look at the interrelated teaches of multiple references; the effects of demands of the marketplace; and the background knowledge possessed by a person of ordinary skill, "all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed." *Id.* at 1740-41. Moreover, the "obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, or motivation, or by overemphasis on the importance of published articles and explicit content of issued patents." *Id.* at 1741. "Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious." *In re Fout*, 675 F.2d 297, 301 (CCPA 1982). It is generally obvious to alter a known product by substituting a known equivalent for one of its components. *See, e.g., Hotchkiss v. Greenwood*, 52 U.S. 248 (1850) (substitution of porcelain door knob in known process of making metal or wood door knobs held obvious);

In re Mayne, 104 F.3d 1339, 1340 (Fed. Cir. 1997) (“Because the applicants merely substituted one element known in the art for a known equivalent, this court affirms [the rejection for obviousness].”)

The evidence of record shows that a known alternative for a mascara brush is depicted in Figure 2 of Ashtary. We find, in the absence of unexpected results, that it is generally obvious to alter the known mascara brush applicator product of Gueret by substituting a known equivalent for one of its brush components as depicted in Ashtary Fig 2.

In addition, the claims do not recite how far the brush portion having a free end may vary in alignment from the longitudinal axis of the one end portion of the stem. Thus, even if both Gueret and Ashtary showed alignment of the stem portion with the brush portion free end, Appellant has provided no evidence of unexpected results associated with a minor variation in alignment of the brush portion free end from the x-axis alignment with the stem. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *KSR*, 127 S. Ct. at 1740.

In view of the evidence before us, we affirm the rejection of claim 1.

Claim 43

Claim 43 is similar to claim 1, however, it claims the curvature of the core in a slightly different manner.

Appellant argues that Gueret and Ashtary lack any disclosure or suggestion of a method of making an applicator, including, among other features, “curving at least a part of [a] blank core so as to form a brush portion comprising . . . a brush portion free end not aligned with a longitudinal axis of an end portion of a stem to which the brush portion is adapted to be connected,” as recited in independent claim 43. (Br. 14.)

Ashtary discloses a mascara brush (Fig. 2) comprising a stem (16) with two opposite ends, a brush portion (32) connected to one end (at 34) portion of the stem, and the one end portion of the stem having a longitudinal axis and the brush portion having a free end that is not aligned with the longitudinal axis of the one end portion of the stem and the brush portion comprising a core (30) having a core free end (free end of brush 32), at least part of the core being curved (col. 3, lines 61-64) such that a line to the core at any axial position along the core is not perpendicular to the longitudinal axis of the one end portion of the stem, and a longitudinal axis of the core free end is not parallel to the longitudinal axis of the end portion (Fig. 2). (FF5.)

Contrary to Appellant’s argument, we find that Ashtary evidences curving at least a part of the blank core so as to form a brush portion comprising a core having a core free end and a brush portion free end not aligned with a longitudinal axis of an end portion of a stem to which the brush portion is adapted to be connected, as claimed in claim 43 (*see* FF 5).

The rejection of claim 43 is affirmed.

2. Claims 14-16 and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gueret in view of Ashtary. Appellant does not separately argue the claims of this rejection so we select claim 14 as representative.

37 C.F.R. § 41.37(c)(1)(vii).

Appellant contends that:

With regard to claims 14-16 and 55, the Office Action acknowledged that neither Gueret nor Ashtary, nor any combination thereof teaches the “shape of the blank surface being [a] frustoconical-shape, fish-like shape, [or] hourglass-like shape.” Office Action, page 4, lines 14-17. The Examiner alleged that such shapes “would have been obvious to one having an ordinary skill in the art at the time the invention was made . . . since such a modification would have involved a mere change in the shape of the component.” Office Action, page 4, lines 17-21. However, the Office Action provided no motivation, suggestion, or teaching to alter the shapes of the devices of Gueret or Ashtary. In particular, the Office Action merely relies on the Examiner's unsupported, hindsight speculation, rather than any evidence.

(Br. 20, emphasis omitted.)

Gueret discloses a mascara brush having a fish-like shape (Gueret, Fig. 1), and a frustoconical shape (Fig. 2A). (FF9.) Both Gueret and Ashtary evidence that those of ordinary skill in the art understand that mascara brushes may be curved. (FF 5, 10.) Thus, we agree with the Examiner that it would have been obvious to one of ordinary skill in the art that the fish and frustoconical shaped mascara brushes of Gueret could optionally be curved, as indicated by Gueret and Ashtary. “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR Int’l Co. v.*

Teleflex Inc., 550 U.S. 398, ___, 127 S. Ct. 1727, 1742, (2007). The rejection of claim 14 is affirmed.

CONCLUSION OF LAW

We conclude that the cited references in combination disclose a brush portion connected to one end portion of the stem, the one end portion of the stem having a longitudinal axis and the brush portion having a free end that is not aligned with the longitudinal axis of the one end portion of the stem,” as in claim 1.

We further find that the cited references disclose “curving at least a part of [a] blank core so as to form a brush portion comprising ... a brush portion free end not aligned with a longitudinal axis of an end portion of a stem to which the brush portion is adapted to be connected,” as recited in independent claim 43.

The obviousness rejections are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

clj

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